

REMARKS

Status of Claims

Claims 1-2 and 4-13 were pending and rejected. Claim 3 has been cancelled without prejudice.

Claim 1 has been amended to correct informalities in the claim language and to more clearly define the claimed subject matter. No new matter has been added.

Rejections under 35 U.S.C. § 103(a)

Claims 1, 2, 4-7 and 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishiguchi et al. (USP 6,242,097) in view of Mehan et al. (USP 6,403,889). Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishiguchi et al. in view of Mehan et al. further in view of Tanmachi et al. (JP 07-078518). Applicants respectfully traverse this rejection for at least the following reasons.

First, Applicants respectfully direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Further, applicants respectfully direct the Examiner's attention to basic requirement of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the references or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F 2d 488,20 USPQ2d 1438 (Fed. Cir. 1991). Section 2143.03 states that all claim limitations must be taught or suggested by the prior art.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F .2D 1382, 1385, 165 USPQ 494,496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F .2d 1071, 5 USPQ2d 1596(Fed. Cir. 1998).

Turning to the rejection of Claim 1, the Examiner asserts that Nishiguchi discloses, among other things, that an outer sheath includes at least one flame retardant selected from the group consisting of metal hydroxides and flame retardants containing nitrogen in a molecule in an amount of 3 ~ 35 parts by weight per 100 parts by weight of the resin mixture. Applicants respectfully submit that amended claim 1 now recites, among other thing, an outer sheath including a halogen free flame retardant containing nitrogen in a molecule in an amount of 3 ~ 35 parts by weight per 100 parts by weight of the resin mixture included in a halogen flee flame retardant cable. Although it appears that Nishiguchi discloses as a frame retarder, ethylenebistetrabromophthalimide, which contains nitrogen, this retarder contains bromine, i.e. halogen, and therefore Nishiguchi fails to disclose a halogen free flame retardant containing nitrogen included in a halogen flee flame retardant cable as required in amended claim 1.

Further, it is noted that Mehan also fails to disclose a flame retardant containing nitrogen for a halogen free flame retardant cable.

It is well established that in order to establish *prima facie* obviousness under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. At a minimum, the cited prior art does not disclose expressly or inherently the above recited limitations. Therefore, Applicants respectfully request that rejection of Claim 1 be withdrawn. Since Claims 2 and 4-13 are dependent claims upon Claim 1, it is submitted that these claims are also allowable for at least the same reasons as Claim 1.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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